

Remarks

In view of the following remarks, favorable reconsideration of the outstanding office action is respectfully requested. Claims 10, 12-17, and 19-26 remain in this application. Claims 1-9 have been previously withdrawn. Claims 11 and 18 were previously cancelled.

1. Terminal Disclaimer

The Examiner is thanked for the indication that the Terminal Disclaimer has been entered.

2. 35 U.S.C. § 103 Rejections

Claims 10, 12-17 and 19-26 are rejected under 35 USC 103(a) as being unpatentable over Applicant's Prior Art Teaching, found on pages 1-2 of the present specification (hereinafter "PAT" in view of Smith (The Wealth of Nations Book 1, Chapter 1).

Respectfully, the rejection of claims 10, 12-17 and 19-26 is traversed.

PAT teaches a conventional prior art drawing method wherein the gobbing takes place in the draw furnace and thereafter fiber draw is commenced within the same draw furnace. Smith teaches broadly and generally the concept of division of labor, i.e., reducing every man's business to some one simple operation thereby increasing the dexterity of the workman, saving time in passing work to another, and application of proper machinery.

Smith is a general theoretical teaching, is extremely vague, and provides no specific guidance as to how one might modify a conventional prior art fiber draw process to improve the efficiency thereof. It is clear from the case law when a suggestion is so broad as to suggest a virtually endless number of possibilities, the search ends up being no more than an opportunity for the exercise of impermissible hindsight reasoning. Very applicable to the facts in this case are In re Deuel which stands for the proposition that more than "general guidance" is needed to render a technique obvious, and In re Dembiczak indicating the showing of combinability must be "clear and particular." In re Deuel, 34 USPQ 2d, 1210, 1216 (Fed. Cir. 1995); In re Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

In particular, the standard that Examiner imposes amounts to "obvious to try," a standard which the court has repeatedly rejected as improper. In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988). Furthermore, "[the] case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or

motivation to combine prior art references.” In *re* Dembiczak, 175 F.3d 994, 999 [50 USPQ2d 1614] (Fed. Cir. 1999). In particular, the admonition against "obvious to try" has been directed to exploring a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only “general guidance” as to the particular form of the claimed invention or how to achieve it. *In re Dow Chemical Co.*, 837 F.2d, 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1985).

In the present case, Applicant recognized the time savings and cost advantages of off-line gobbing in a separate furnace and designed an apparatus and method for efficiently accomplishing this. Neither PAT nor Smith mentions such an advantage nor mentions the desirability of doing so. There is no “clear and particular” suggestion offered in PAT or Smith that would lead one of ordinary skill in the art to the claimed invention, i.e., to select an off-line gobbing method wherein the preform is pre-gbbed in a furnace and then transferred to the draw furnace with a pre-optimized draw tip. Smith offers only “general guidance” and does not, therefore, provide the required “clear suggestion” to modify PAT in the manner suggested by the Examiner. Accordingly, the rejection of claims 10, 12-17 and 19-26 under 35 U.S.C. § 103(a) should be withdrawn.

3. Conclusion

Based upon the above remarks, and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 10, 12-17 and 19-26 and a prompt Notice of Allowance thereon.

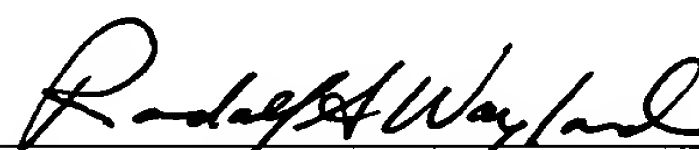
Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Reply timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Please direct any questions or comments to Randall S. Wayland at 607-974-0463.

Respectfully submitted,

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Date: 12/8/03


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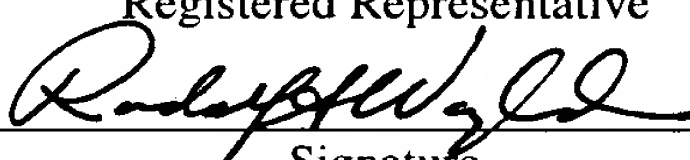
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